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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/117,921 03/04/99 BROUN

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EXAMINER

MCELWAIN, E

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/117,921

Applicant(s)

BROUN ET AL.

Examiner

Elizabeth McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-34 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

Applicants are reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Upon election of Group V below, Applicant is additionally required to select a single nucleotide sequence selected from SEQ ID Nos: 1-3. If SEQ ID NO: 3 is elected, then the claims to nucleic acids encoding the amino acid sequence of SEQ ID NO: 4 will also be examined. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 10, drawn to a method of decreasing fatty acid desaturase activity by mutating the endogenous gene for fatty acid hydroxylase, classified in class 800, subclass 276, for example.
- II. Claim 1, 3-5, 10-13 and 16, drawn to a method of decreasing fatty acid desaturase activity by transforming a plant with a fatty acid hydroxylase gene, classified in class 800, subclass 281, for example.

III. Claims 1, 6 and 10, drawn to a method of decreasing fatty acid desaturase activity by mutating the endogenous gene for fatty acid desaturase, classified in class 800, subclass 276, for example.

IV. Claims 1, 7-11 and 14-16, drawn to a method of decreasing fatty acid desaturase activity by transforming a plant with a fatty acid desaturase gene, classified in class 800, subclass 281, for example.

V. Claims 17-23, 25 and 26, drawn to a recombinant nucleic acid encoding a fatty acid hydroxylase from *Lesquerella*, classified in class 536, subclass 23.2, for example. (If this group is elected, then also elect one of SEQ ID NO: 1 or SEQ ID NO: 2 or SEQ ID NOs: 3 and 4, as stated above)

VI. Claims 23, 25 and 26, drawn to a recombinant nucleic acid encoding a fatty acid desaturase from *Lesquerella*, classified in class 536, subclass 23.6, for example.

VII. Claims 23, 24 and 26, drawn to a recombinant nucleic acid encoding a fatty acid hydroxylase from *Ricinus*, classified in class 536, subclass 23.6, for example.

VIII. Claims 23, 24 and 26, drawn to a recombinant nucleic acid encoding a fatty acid desaturase from *Lesquerella*, classified in class 536, subclass 23.6, for example.

- IX. Claims 27 and 31 drawn to a method of decreasing fatty acid desaturase activity further comprising processing the seed to obtain oil and meal, classified in class 554, subclass 9, for example.
- X. Claims 28 and 32, drawn to oil extracted from seed, classified in class 554, subclass 1, for example.
- XI. Claims 29 and 33, drawn to meal extracted from seed, classified in class 530, subclass 370, for example.
- XII. Claims 30 and 34, drawn to a plant, classified in class 800, subclass 298, for example.

The inventions are distinct, each from the other because:

The inventions of Groups I-XII are distinct products and methods, wherein one is not required by the other. The methods of Groups I-IV and IX differ one from each of the others in requiring different components and method steps, as well as differing in their starting and end-products. In addition, the recombinant nucleic acids and other products of Groups V-VIII and X-XII are each distinct products that differ chemically and structurally and can be used independently from the methods of Groups I-IV and IX, such as for production of the enzymes in a bacterial cell, for example; and are not required by the methods, which could use any one of the other nucleic acids. Thus the inventions of Groups I-XII are each capable of being separately made, independently used and the patentability of one would not render the other obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

5 Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the  
10 currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to  
15 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this  
20 Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

25 Elizabeth F. McElwain, Ph.D.  
July 2, 2001

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1638  
*Elizabeth F. McElwain*